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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/129,758	08/05/98	WALDMANN	R 989.6781P

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EXAMINER
BASIN

ART UNIT	PAPER NUMBER
1646	13

DATE MAILED: 05/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Restarted office action

Office Action Summary

Application No.

09/129,758

Applicant(s)

WALDMANN et al

Examiner

Nirmal. S. Basi

Group Art Unit

1646

☒ Responsive to communication(s) filed on Sep 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Response to restriction requirement filed 9/27/00 (paper number 12) has been entered.

Missing pages

2. Applicants arguments filed 9/27/00 have been taken into consideration and found

persuasive in part. Examiners last restriction was based on the claims as originally filed.

Applicant filed an Amendment on 1/1/99 which was entered in the Application as paper number 3, but the claims were not amended per the Applicants instructions. In view of the Amendment in paper number 3, a new restriction is necessitated. Applicant has proposed the following three

Groups: Applicant has proposed the following three Groups:

Group I: Claims 1-3, 5, 10-13, 15 and 17-25

Group II: Claims 1, 4 10-11, 14 and 17-25

Group III: Claims 1, 6 , 10-11 and 16-25

Applicant has failed to mention claims 7-9.

Applicants arguments filed 3/7/00 have been taken into consideration in the grouping of the claims. Examiner has kept the general concept of the restriction as proposed by the Applicant, but restricted the antibody and fusion proteins into separate groups.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

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In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-3, 5, 11-13, 15 and 17-24 drawn to protein constituting a mammalian neuronal cationic channel comprising SEQ ID NO:2, 4 and 8; encoded by the nucleic acid of SEQ ID NO:s 1, 3 and 7, vector comprising said nucleic acid, cell containing said vector, method of expressing said protein and method of screening for substances capable of modulating the activity of mammalian neuronal ion channels, and pharmaceutical composition comprising said protein.
- II. Claims 1, 4, 11, 14 and 17-24 drawn to protein constituting a mammalian neuronal cationic channel comprising SEQ ID NO:6, encoded by the nucleic acid of SEQ ID NO:5, vector comprising said nucleic acid, cell containing said vector, method of expressing said protein and method of screening for substances capable of modulating the activity of mammalian neuronal ion channels, and pharmaceutical composition comprising said protein.
- III. Claims 1, 6, 11 and 16-24 drawn to protein constituting a mammalian neuronal cationic channel comprising SEQ ID NO:10, encoded by the nucleic acid of SEQ ID NO:9, vector comprising said nucleic acid, cell containing said vector, method of expressing said protein and method of screening for substances capable of modulating the activity of mammalian neuronal ion channels and pharmaceutical composition comprising said protein.

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IV. Claims 1, 7-9 and 11-24 drawn to hybrid cationic channels comprising SEQ ID NO:2, 4, 6, 8 or 10, pharmaceutical composition comprising said hybrid protein..

V. Claim 10 and 24 drawn to antibody and an antibody.

VI. Claim 25 drawn to a use of a chemical or biological substance that is capable of modifying the currents of an ionic channel.

4. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is drawn to the cation channel represented by SEQ ID NO:2, 4 and 8. Pursuant 37 CFR 1.475 (d), these claims are considered by the ISA/US to constitute the main invention, and none of the related groups II-VI correspond to the main invention. The special technical feature of Group I is the structure and function of the cation channel represented by the protein consisting of SEQ ID NO:2, 4 or 8. The products of I-VI Groups do not share a special technical feature in any paring because the products are structurally and functionally different and capable of separate use and manufacture.. The methods of Groups I-VI do not share a special technical feature because the methods have materially different process steps using different products and each defines a separate invention over the art. The methods of Groups II-VI do not require the products of Group I. Since no technical feature in any group, other than the main invention, is shared by any other invention, unity of invention is lacking.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently
5 named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Advisory Information

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.


5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15 Nirmal S. Basi
Art Unit 1646
December 18, 2000


YVONNE EYLER, PH.D
PRIMARY EXAMINER